

REMARKS/ARGUMENTS

In response to the Restriction Requirement, the applicants elect Group X, Claims 1-4 to the extent that they are drawn to a composition comprising BMP-6 and FGF-4.

The Restriction Requirement is traversed on the basis that restriction requirements are optional in all cases. MPEP § 803. If the search and examination of a set of claims can be made without serious burden, the Examiner must examine them on the merits, even though they may arguably directed at distinct or independent inventions. MPEP § 803.

In the present application, it is respectfully submitted that claims in Groups I-VII, which are directed at a combination of BMP-4 and one of the FGFs listed, can be examined without serious burden on the patent office. It is further submitted that claims in Groups VIII-XIV, which are directed at a combination of BMP-6 and one of the FGFs listed, can be examined without serious burden on the patent office. It is further submitted that claims in Groups XV-XXI, which are directed at a combination of BMP-7 and one of the FGFs listed, can be examined without serious burden on the patent office. It is further submitted that claims in Groups XII-XXVIII, which are directed at a combination of BMP-12 and one of the FGFs listed, can be examined without serious burden on the patent office. It is further submitted that claims in Groups XXIX-XXXIV, which are directed at a combination of BMP-2 and one of the FGFs listed, can be examined without serious burden on the patent office. It is further submitted that claims in Groups XXXV-CXXXIX, which are directed at methods for inducing cardiogenesis with a combination of a BMP and a FGF, can be examined together and further with any of the other groups of claims as listed above without serious burden on the patent office.

The traverse is supported by the sample searches conducted on behalf of the applicants for the above claim groups. Tables 1 and 2 summarize the results of these searches. As Table 1 demonstrates, for composition claims 1-10, if one searches for a particular BMP listed in the claims and FGF in general in the U.S. Patent and Trademark Office databases for issued U.S. patents and published applications, only a limited number of documents would be uncovered. The applicants expect similar results for searches conducted with Medline.

The search results for method Claims 11-21 are even more striking. As Table 2 demonstrates, if one searches for BMP, FGF and cardiogenesis, only 4 published U.S. applications were found. Two of the 4 applications are the present application and the parent application of the present application. The same search conducted with Medline uncovered only 6 documents.

It is noted that the results shown in Tables 1 and 2 are from unsophisticated searches which tend to uncover many unrelated references along with related references. For example, a document would be uncovered by the searches in Tables 1 and 2 as long as the terms BMP and FGF are mentioned in the document, even if they appear separately in different fields of the document. These searches would also uncover documents published after the priority date of the present application. Therefore, it is expected that the more sophisticated searches conducted by the patent office, such as those limiting the terms BMP and FGF to the same paragraph, sentence or a specific field of the document, or limiting the document's publication date to before the priority date of the present application, will uncover a smaller number of references than those in Tables 1 and 2.

Table 1

Search Terms	Search Fields	U.S. Patents	U.S. Published Application
Bone morphogenetic protein 4 + fibroblast growth factor	All fields	30	24
Bone morphogenetic protein 6 + fibroblast growth factor	All fields	21	2
Bone morphogenetic protein 7 + fibroblast growth factor	All fields	30	34
Bone morphogenetic protein 12 + fibroblast growth factor	All fields	2	0
Bone morphogenetic protein 2 + fibroblast growth factor	All fields	71	35

Table 2

Search Terms	Medline (1966-October) 2003	U.S. Patents (all fields search)	U.S. Published Applications (all fields search)
Bone morphogenetic proteins + fibroblast growth factors + cardiogenesis	6	0	4

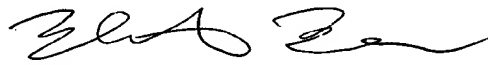
In summary, it is not burdensome on the patent office to examine a group of composition claims the extent that they are drawn to a composition comprising a particular BMP and any of the FGFs listed along with all of the method claims. On the contrary, it will be unnecessarily burdensome on both the applicants and the patent office to consider the highly related subject matter in many separate patent applications. For this reason, it is respectfully requested that the restriction requirement be reconsidered and withdrawn.

Specifically, it is requested that Claims 1-4 to the extent that they are drawn to a composition comprising BMP-6 and any of FGFs listed in the claims and Claims 11-21 be examined together.

Wherefore examination on the merits is respectfully requested.

A petition for four months extension of time accompanies this response so that the response will be deemed to have been timely filed. If any other extension of time is required in this or any subsequent response, please consider this to be a petition for the appropriate extension and a request to charge the petition fee to the Deposit Account No. 17-0055. No other fee is believed to be due in connection with this response. However, if any fee is due in this or any subsequent response, please charge the fee to the same Deposit Account No. 17-0055.

Respectfully submitted,



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